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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,324

11/20/2003

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MBI-1136DIV1

1057

21302 7590 02/22/2007

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EXAMINER

GROSSO, HARRY A

ART UNIT

PAPER NUMBER

3781

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/718,324

Applicant(s)

MCDONOUGH ET AL.

Examiner

Harry A. Grosso

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-34, 37, 38, 43, 44, 46, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adado in view of Valyi, both of record.

3. Regarding claims 22 and 28, Adado discloses a drinking cup usable by a child fabricated from a first material (12, column 4, lines 3-7) and a second material (14, column 4, lines 33-40), with a lid (16, Figures 6 and 7, column 3, lines 65-66) and the first material of Adado would be harder (have a higher durometer value) than the second material of Adado. Adado does not teach that the second material is integrally molded to the first material. Valyi discloses a cup capable of being used as a drinking cup with a first material (23, Figures 2A) and a second material integrally molded to the first material (35, column 3, line 66 to column 4, line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a first material and a second material integrally molded to the first material as disclosed by Valyi in the drinking cup disclosed by Adado to provide a method of producing the drinking cup that does not require the extra step of forming a sleeve from sheet material or the use of adhesive to secure the first material to the second material.

4. Regarding claim 37, Adado discloses a drinking cup (12, Figures 6-7 and column 4, lines 3-6) with an elastomeric outer sleeve (14, Figures 6-7, abstract and column 4, lines 33-40). Adado does not teach that the outer sleeve is overmolded to the cup. Valyi discloses a cup capable of being used as a drinking cup with an inner body (23, Figures 2A) and a single layer overmolding formed over the body and the bottom (35, column 3, line 66 to column 4, line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of an inner body

and a single layer overmolding formed over the body as disclosed by Valyi in the drinking cup disclosed by Adado to provide a method of producing the drinking cup that does not require the extra step of forming a sleeve from sheet material or the use of adhesive to secure the overmolding to the body.

5. Regarding claim 38, Valyi discloses the overmolding covers the bottom of the body to protect the body (Figure 2A). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of an overmolding that completely covers the bottom of the body as disclosed by Valyi in the drinking cup disclosed by Adado to add strength and increase protection to the body of the drinking cup.

6. Regarding claims 23, 29 and 43 Adado discloses the body or first material is polypropylene (column 4, lines 3-7).

7. Regarding claims 24, 30 and 44, Adado discloses the overmolding or second material is a thermoplastic elastomer (column 4, lines 33-40).

8. Regarding claims 26, 32 and 49, Adado discloses the cup or first material is polypropylene and the overmolding or second material is a TPE, thus the fusion bond would be a TPE/polypropylene bond.

9. Regarding claims 27, 33 and 34, Adado discloses the second material forms a perimeter of a portion of the first material and substantially surrounds a portion of the first material.

10. Regarding claim 46, it has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See In re

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Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. Thorpe, 777 F.2d at 697, 227 USPQ at 966; In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). The examiner considers the phrase "bi-component molding" to constitute a product by process limitation that does not materially affect the structure of the product, a drinking cup with an overmolding, which is disclosed by Adado and Valyi.

11. Regarding claims 25, 31 and 47, Valyi disclosed the molding process results in a composite container (column 4, lines 2-10). In the previous Office action the examiner took official notice that it is well known in the art that the molding process as disclosed by Valyi would result in a fusion bond between the body or first material and the overmolding or second material. Applicant did not traverse the official notice in his response to the Office action. Therefore, it is taken to be admitted prior art that the molding process as disclosed by Valyi would result in a fusion bond between the body or first material and the overmolding or second material.

12. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adado as modified by Valyi in view of Coy, of record.

13. Regarding claim 35, Adado and Valyi disclose the invention of except for the use of a valve in the lid. Coy discloses a child's drinking cup with a lid and the lid has a

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spout (9) with a valve (V, Figure 1, column 3, lines 26-32) to prevent spillage (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a spout with a valve as disclosed by Coy in the drinking cup disclosed by Adado and Valyi to protect against spillage.

14. Regarding claim 36, Adado and Valyi disclose a feeding device (drinking cup) with a body, a lid and a gripping area consisting of a first material with a second material molded over it; the first material (polypropylene) would have a harder durometer value than the second material (a foam TPE) and the second material substantially surrounds a portion of the first material. Adado and Valyi do not teach the use of a valve in the lid. Coy discloses a child's drinking cup with a lid and the lid has a spout (9) with a valve (V, Figure 1, column 3, lines 26-32) to prevent spillage (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a spout with a valve as disclosed by Coy in the drinking cup disclosed by Adado and Coy to protect against spillage.

15. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adado as modified by Valyi in view of Tunberg, of record. Adado and Valyi disclose the invention except for the overmolding having ribs. Tunberg discloses an overmolding with a plurality of ribs formed by the surface (18) and grooves (19) extending circumferentially about the body to provide a roughened surface to improve gripping of the cup. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of an overmolding with a plurality of ribs extending circumferentially about the body as disclosed by Tunberg in the drinking

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cup disclosed by Adado and Valyi to provide a roughened surface to improve gripping of the cup.

16. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adado as modified by Valyi in view of Hirata et al, of record. Adado and Valyi disclose the invention except for the use of longitudinal depressions in the body. Hirata et al discloses a molded multilayer container with longitudinal depressions (57, Figures 6 and 8) in the body of the container for gripping the container and the overmolding layer (3, Figure 3) covers the depressions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of longitudinal depressions in the body of the container gripping the container and the overmolding layer that covers the depressions as disclosed by Hirata et al in the drinking cup disclosed by Adado and Valyi for gripping the drinking cup.

17. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adado as modified by Valyi in view of Wehnert, III (Wehnert), of record. Adado and Valyi disclose the invention except for a durometer value for the overmolding. Wehnert discloses an overmolding (10, Figure 4) with a durometer in the range of 40 to 70 Shore A (column 1, lines 47-51) to provide a highly elastomeric material for tight fitting overmolding. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use an overmolding with a durometer in the range of 40 to 70 Shore A as disclosed by Wehnert in the drinking cup disclosed by Adado to provide a highly elastomeric material for tight fitting overmolding.

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18. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adado and Valyi in view of Goth, of record. Adado and Valyi disclose the drinking cup of claim 18 with an overmolding made from a thermoplastic elastomer (TPE) but do not teach that the overmolding is fusion bonded to the body with a bond strength greater than the tensile strength of the overmolding material. Goth discloses a fusion bond of a liner with a heat seal polymer to a container and the fusion bond is stronger than the tensile strength of the polymer material so that a residue of the polymer material is left on the container if the liner is removed providing tamper evidence (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a fusion bond of a liner (overmolding) with a heat seal polymer to a container with the fusion bond stronger than the tensile strength of the polymer material as disclosed by Goth in the drinking cup disclosed by Adado and Valyi so that a residue of the polymer material is left on the container if the liner is removed providing a tamper evidence.

Response to Arguments

Applicant's arguments filed December 1, 2006 have been fully considered but they are not persuasive.

19. In response to applicant's argument that Valyi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both

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Adado and Valyi disclose plastic cups with outer sleeves that are capable of providing some level of insulation, and both are capable of being used as drinking cups. Thus, Adado and Valyi are analogous art.

20. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Adado and Valyi disclose plastic cups with outer sleeves. The method of applying the outer sleeve as an overmolding as disclosed by Valyi would be knowledge generally available to one of ordinary skill in the art.

21. Applicant argues that the outer overmolding of Valyi is provided for a different purpose than the outer sleeve of Adado and would not function as intended by Adado. In response, Valyi is used to teach the overmolding of the outer sleeve on the inner body. In addition, Valyi teaches that the process can be used with a wide variety of materials to provide the desired properties (Valyi, column 4, lines 61-66). Thus, the selection of a material capable of providing the properties delineated by Adado is not precluded by Valyi.

22. Applicant argues that there is no reasonable expectation of success if the process taught by Valyi is used for the container of Adado since different materials are

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used by Adado and Valyi. In response, Valyi teaches that the process can be used with a wide variety of materials to provide the desired properties (Valyi, column 4, lines 61-66). In addition, the outer sheath of Adado is formed by extrusion of the polyolefin elastomeric material and Valyi discloses the use of an extrusion process to form the overmolding on his cup. One of ordinary skill in the art would have knowledge of the use of extrusion as a process used with elastomeric materials.

23. Applicant argues that the overmolding of Valyi is not an elastomeric material. In response, Adado discloses the use of an elastomeric material for the overmolding. In addition, Valyi discloses a variety of materials can be used in his container to provide the desired properties.

24. Applicant alleges significant commercial success linked to the claimed invention but has provided no documentation to support the allegation.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

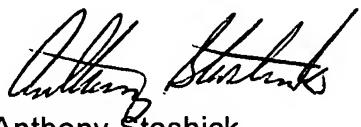
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony Stashick
Supervisory Patent Examiner
Art Unit 3781

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